

Appln. No. 09/991,041  
Amendment dated January 11, 2005  
Reply to Office Action mailed October 14, 2004

### REMARKS

Reconsideration is respectfully requested.

Claims 1 through 6, 8, 9 and 11 through 19 remain in this application.  
Claims 7 and 10 have been cancelled.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

#### Paragraph 1 of the Office Action

The specification has been objected to for the informalities noted in the Office Action.

The specification has been amended in a manner believed to clarify any informalities in the language, particularly at the points identified in the Office Action.

Withdrawal of the objection is respectfully requested.

#### Paragraph 2 of the Office Action

Claims 11 and 19 have been objected to for the informalities noted in the Office Action.

Claims 11 and 19 have been amended in a manner believed to clarify any informalities in the language, particularly at the points identified in the Office Action.

Withdrawal of the objection to claims 11 and 19 is therefore respectfully requested.

#### Paragraph 3 of the Office Action

Claim 19 has been rejected under 35 U.S.C. §112 (second paragraph) as being indefinite.

The above amendments to the claims are believed to clarify the requirements of the rejected claims, especially the particular points identified in the Office Action.

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Withdrawal of the §112 rejection of claim 19 is therefore respectfully requested.

**Paragraphs 4 and 5 of the Office Action**

Claims 1-3 have been rejected under 35 U.S.C. §102(b) as being anticipated by Kolka (US Pat. 4,180,261).

It is submitted that the Kolka reference does not disclose, teach or suggest "said plurality of pockets comprises a pair of pockets being coupled to the associated one of said body members, a first of said pockets being coupled proximate a leading edge of the associated one of said body members, a second of said pockets being coupled to the associated one of said body members proximate said trailing edge of the associated one of said body members such that said second of said pockets is adapted for being positioned on an opposite side of the forearm of the user from said first of said pockets, said pockets being adapted for spreading the weight from said weight members evenly over the forearm of the user". The Kolka reference teaches an exercising device for runners that fails to teach at least one of the body members fitting on the forearm of the user having a first of the pockets positioned proximate the leading edge of the body member and a second of the pockets being positioned proximate the trailing edge of the body member with the first of the pockets being positioned on an opposite side of the forearm from the second of the pockets. Therefore, it is submitted that the Kolka reference would not lead one to anticipate the combination of features as claimed by the applicant.

Claims 2 and 3 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2 and 3 are also believed to be allowable over the cited reference.

Withdrawal of the §102(b) rejection of claims 1-3 is therefore respectfully requested.

**Paragraph 6 of the Office Action**

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Claims 1 and 5-7 have been rejected under 35 U.S.C. §102(b) as being anticipated by Winston (US Pat. 4,838,546).

It is submitted that the Winston reference does not disclose, teach or suggest "said plurality of pockets comprises a pair of pockets being coupled to the associated one of said body members, a first of said pockets being coupled proximate a leading edge of the associated one of said body members, a second of said pockets being coupled to the associated one of said body members proximate said trailing edge of the associated one of said body members such that said second of said pockets is adapted for being positioned on an opposite side of the forearm of the user from said first of said pockets, said pockets being adapted for spreading the weight from said weight members evenly over the forearm of the user". The Winston reference teaches an ankle exercise weight that fails to teach at least one of the body members fitting on the forearm of the user having a first of the pockets positioned proximate the leading edge of the body member and a second of the pockets being positioned proximate the trailing edge of the body member with the first of the pockets being positioned on an opposite side of the forearm from the second of the pockets. Therefore, it is submitted that the Winston reference would not lead one to anticipate the combination of features as claimed by the applicant.

Claims 5 and 6 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 5 and 6 are also believed to be allowable over the cited reference.

Claim 7 has been cancelled.

Withdrawal of the §102(b) rejection of claims 1 and 5-7 is therefore respectfully requested.

**Paragraph 7 of the Office Action**

Claims 1 and 13-17 have been rejected under 35 U.S.C. §102(b) as being anticipated by Franco-Sion (US Pat. 6,557,176 B2).

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It is submitted that the Franco-Sion reference does not disclose, teach or suggest "said plurality of pockets comprises a pair of pockets being coupled to the associated one of said body members, a first of said pockets being coupled proximate a leading edge of the associated one of said body members, a second of said pockets being coupled to the associated one of said body members proximate said trailing edge of the associated one of said body members such that said second of said pockets is adapted for being positioned on an opposite side of the forearm of the user from said first of said pockets, said pockets being adapted for spreading the weight from said weight members evenly over the forearm of the user". The Franco-Sion reference teaches a weighted vest that fails to teach at least one of the body members fitting on the forearm of the user having a first of the pockets positioned proximate the leading edge of the body member and a second of the pockets being positioned proximate the trailing edge of the body member with the first of the pockets being positioned on an opposite side of the forearm from the second of the pockets. Therefore, it is submitted that the Franco-Sion reference would not lead one to anticipate the combination of features as claimed by the applicant.

Claims 13 through 17 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 13 through 17 are also believed to be allowable over the cited reference.

Withdrawal of the §102(b) rejection of claims 1 and 13-17 is therefore respectfully requested.

**Paragraph 8 of the Office Action**

Claims 1, 11 and 12 have been rejected under 35 U.S.C. §102(b) as being anticipated by Biggs, Jr. et al. (US Pat. 3,306,610).

It is submitted that the Biggs, Jr. reference does not disclose, teach or suggest "said plurality of pockets comprises a pair of pockets being coupled to the associated one of said body members, a first of said pockets being

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coupled proximate a leading edge of the associated one of said body members, a second of said pockets being coupled to the associated one of said body members proximate said trailing edge of the associated one of said body members such that said second of said pockets is adapted for being positioned on an opposite side of the forearm of the user from said first of said pockets, said pockets being adapted for spreading the weight from said weight members evenly over the forearm of the user". The Biggs, Jr. reference teaches a weighted training spat that fails to teach at least one of the body members fitting on the forearm of the user having a first of the pockets positioned proximate the leading edge of the body member and a second of the pockets being positioned proximate the trailing edge of the body member with the first of the pockets being positioned on an opposite side of the forearm from the second of the pockets. Therefore, it is submitted that the Biggs, Jr. reference would not lead one to anticipate the combination of features as claimed by the applicant.

Claims 11 and 12 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 11 and 12 are also believed to be allowable over the cited reference.

Withdrawal of the §102(b) rejection of claims 1, 11 and 12 is therefore respectfully requested.

**Paragraphs 9 and 10 of the Office Action**

Claims 1 and 7-10 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Jackson, Jr. (US Pat. 3,759,510).

It is submitted that the Jackson, Jr. reference does not disclose, teach or suggest "said plurality of pockets comprises a pair of pockets being coupled to the associated one of said body members, a first of said pockets being coupled proximate a leading edge of the associated one of said body members, a second of said pockets being coupled to the associated one of said body members proximate said trailing edge of the associated one of said body members such that said second of said pockets is adapted for

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being positioned on an opposite side of the forearm of the user from said first of said pockets, said pockets being adapted for spreading the weight from said weight members evenly over the forearm of the user". The Jackson, Jr. reference teaches an exercise garment that fails to teach at least one of the body members fitting on the forearm of the user having a first of the pockets positioned proximate the leading edge of the body member and a second of the pockets being positioned proximate the trailing edge of the body member with the first of the pockets being positioned on an opposite side of the forearm from the second of the pockets. Further, the Jackson, Jr. reference is completely lacking in any motivation to modify the Jackson, Jr. reference in an attempt to meet the requirements of the applicant's claim. It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980)

(emphasis in original).

Therefore, it is submitted that the Jackson, Jr. reference would not lead one to the combination of features as claimed by the applicant.

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Claims 8 and 9 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 8 and 9 are also believed to be allowable over the cited reference.

Claims 7 and 10 have been cancelled.

Withdrawal of the §103(a) rejection of claims 1 and 7-10 is therefore respectfully requested.

**Paragraph 11 of the Office Action**

Claim 4 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Kolka (US Pat. 4,180,261) in view of Spletzer (US Pat. 6,039,677).

It is submitted that the combination of Kolka with Spletzer is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "said plurality of pockets comprises a pair of pockets being coupled to the associated one of said body members, a first of said pockets being coupled proximate a leading edge of the associated one of said body members, a second of said pockets being coupled to the associated one of said body members proximate said trailing edge of the associated one of said body members such that said second of said pockets is adapted for being positioned on an opposite side of the forearm of the user from said first of said pockets, said pockets being adapted for spreading the weight from said weight members evenly over the forearm of the user". As discussed above, the Kolka reference fails to teach at least one of the body members fitting on the forearm of the user having a first of the pockets positioned proximate the leading edge of the body member and a second of the pockets being positioned proximate the trailing edge of the body member with the first of the pockets being positioned on an opposite side of the forearm from the second of the pockets as claimed by the applicant. The Spletzer reference teaches an exercise thigh weight system that fails to teach at least one of

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the body members fitting on the forearm of the user having a first of the pockets positioned proximate the leading edge of the body member and a second of the pockets being positioned proximate the trailing edge of the body member with the first of the pockets being positioned on an opposite side of the forearm from the second of the pockets as claimed by the applicant. Therefore, it is submitted that the combination of the Kolka reference with the Spletzer reference would not lead one to the combination of the features as claimed by the applicant.

Claim 4 is dependent upon claim 1, particularly as amended, and therefore incorporates the requirements of claim 1. Thus, claim 4 is also believed to be allowable over the cited reference

Withdrawal of the §103(a) rejection of claim 4 is therefore respectfully requested.

**Paragraph 12 of the Office Action**

Claim 18 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Franco-Sion (US Pat. 6,557,176 B2) in view of Cook (US Pat. 6,554,752 B2).

It is submitted that the combination of Franco-Sion with Cook is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "said plurality of pockets comprises a pair of pockets being coupled to the associated one of said body members, a first of said pockets being coupled proximate a leading edge of the associated one of said body members, a second of said pockets being coupled to the associated one of said body members proximate said trailing edge of the associated one of said body members such that said second of said pockets is adapted for being positioned on an opposite side of the forearm of the user from said first of said pockets, said pockets being adapted for spreading the weight from said weight members evenly over the forearm of the user". As discussed above,



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the Franco-Sion reference fails to teach at least one of the body members fitting on the forearm of the user having a first of the pockets positioned proximate the leading edge of the body member and a second of the pockets being positioned proximate the trailing edge of the body member with the first of the pockets being positioned on an opposite side of the forearm from the second of the pockets as claimed by the applicant. The Cooks reference teaches a weighted exercise apparatus that fails to teach at least one of the body members fitting on the forearm of the user having a first of the pockets positioned proximate the leading edge of the body member and a second of the pockets being positioned proximate the trailing edge of the body member with the first of the pockets being positioned on an opposite side of the forearm from the second of the pockets as claimed by the applicant. Therefore, it is submitted that the combination of the Franco-Sion reference with the Cooks reference would not lead one to the combination of the features as claimed by the applicant.

Claim 18 is dependent upon claim 1, particularly as amended, and therefore incorporates the requirements of claim 1. Thus, claim 18 is also believed to be allowable over the cited reference

Withdrawal of the §103(a) rejection of claim 18 is therefore respectfully requested.

**Paragraph 13 of the Office Action**

Claim 19 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Jackson, Jr. (US Pat. 3,759,510) in view of Speltzer (US Pat. 6,039,677), Winston (US Pat. 4,838,546) and Biggs, Jr. et al. (US Pat. 3,306,610).

It is submitted that the combination of Jackson, Jr. with Speltzer, Winston and Biggs, Jr. is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "said plurality of pockets comprises a pair of

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pockets being coupled to the associated one of said body members, a first of said pockets being coupled proximate a leading edge of the associated one of said body members, a second of said pockets being coupled to the associated one of said body members proximate said trailing edge of the associated one of said body members such that said second of said pockets is adapted for being positioned on an opposite side of the forearm of the user from said first of said pockets, said pockets being adapted for spreading the weight from said weight members evenly over the forearm of the user". As discussed above, the Jackson, Jr. reference fails to teach at least one of the body members fitting on the forearm of the user having a first of the pockets positioned proximate the leading edge of the body member and a second of the pockets being positioned proximate the trailing edge of the body member with the first of the pockets being positioned on an opposite side of the forearm from the second of the pockets as claimed by the applicant and further fails to provide any motivation for such a modification. As discussed above, the Spletzer, Winston and Briggs, Jr. references fail to teach at least one of the body members fitting on the forearm of the user having a first of the pockets positioned proximate the leading edge of the body member and a second of the pockets being positioned proximate the trailing edge of the body member with the first of the pockets being positioned on an opposite side of the forearm from the second of the pockets as claimed by the applicant. It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law

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which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980)

(emphasis in original).

Therefore, it is submitted that the combination of the Jackson, Jr. reference with the Spletzer, Winston and Briggs, Jr. references would not lead one to the combination of the features as claimed by the applicant.

It is further submitted that the need to combine a multiplicity of references in an attempt to meet the claimed invention is evidence of nonobviousness.

In this particular instance four references are combined. As discussed more fully above, the references must suggest the proposed combination in order to establish obviousness. Not only do none of the references suggest combination with any other single reference, there is absolutely no suggestion by any reference that as many as two other references should be combined with the potential primary reference.

Withdrawal of the §103(a) rejection of claim 19 is therefore respectfully requested.


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**CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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By 

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